

REMARKS

Reconsideration and allowance of the claims are requested in view of the above amendments and the following remarks. Claims 1, 9, 14 and 63 have been amended. Support for the claim amendments may be found in the specification and claims as originally filed. No new matter has been added.

Claims 7, 15-62 and 66-83 have been canceled without prejudice or disclaimer.

Upon entry of this amendment, claims 1-6, 8-14 and 63-65 are pending with claims 1, 14 and 63 being independent.

Applicants thank Examiner Nguyen for the courtesies extended to applicants' representative, Mr. Sung Kim, during a telephonic interview conducted on April 1, 2010. The substance of the interview is incorporated in the following remarks.

1. Rejections Under 35 U.S.C. §103

A. Rejections Based on Kaker et al., Capps, Venkatesh et al. and Green et al.

The Office Action rejects claims 1-6, 8-14 and 63-64 under 35 U.S.C. §103(a) as being unpatentable over Kaker et al. (2001/0037218) in view of Capps (5,666,502), in view of Venkatesh et al. (2003/0201320), and further in view of Green et al. (6,449,598). Applicants respectfully traverse this rejection for at least the following reasons.

1) Office Action Rejections Fail to Consider Each and Every Element of the Independent Claims

As discussed during the interview, the present Office Action fails to consider how the cited references teach or suggest **each and every element** of independent claims 1, 14 and 63. Therefore, the Office Action fails to establish a prima facie case of obviousness in rejecting the independent claims (and their respective dependent claims).

The Examiner is respectfully directed to MPEP 2143.03, which states in part (emphasis added):

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"All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

However, in rejecting independent claims 1, 14 and 63 on pages 2-4 and 9 of the Office Action, the Office Action fails to consider several elements recited in the independent claims (as previously presented). For example, the Office Action fails to consider or provide any explanation for how the cited references teach or suggest at least the following elements of independent claims 1, 14 and 63 as previously presented, respectively (emphasis added):

1. A computer-implemented method, comprising:
... the solution defining an availability of one or more actions for formatting data into one or more operable fields of an electronic form associated with the data file, wherein the availability of one or more actions is defined for each one of the one or more operable fields;

...
receiving input from the user to set the context of a selected operable field;

in response to the context set by the user, displaying to the user the availability of the one or more actions for formatting data in the selected operable field of the electronic form; and

after displaying the availability of the one or more actions, enabling the user to format data, based on the availability of the one or more actions, in the selected operable field of the electronic form.

14. One or more computer-readable storage media having stored thereon a plurality of computer-executable instructions performing steps comprising:

... the solution defining an availability of one or more actions for formatting data in one or more operable fields of an electronic form associated with the data file, wherein the availability of one or more actions is defined for each one of the one or more operable fields;

...
receiving input from the user to set the context of a selected operable field;

in response to the context set by the user, displaying to the user the availability of the one or more actions for formatting data in the selected operable field of the electronic form; and

after displaying the availability of the one or more actions, enabling the user to format data, based on the availability of the one or more actions, in the selected operable field of the electronic form.

63. An apparatus comprising:

. . . the solution defines an availability of one or more actions for formatting data in one or more operable fields of an electronic form associated with the data file, wherein the availability of one or more actions is defined for each one of the one or more operable fields;

. . . means for receiving input from a user to set the context of a selected operable field;

means for displaying, in response to the context set by the user, the availability of the one or more actions to the user for formatting data in the selected operable field of the electronic form;

means for, after displaying the availability of the one or more actions, enabling the user to format data, based on the availability of the one or more actions, in the selected operable field of the electronic form; . . .

Therefore, applicants submit that the rejection of claims 1, 14 and 63 (and their respective dependent claims) under 35 U.S.C. §103(a) is improper. Applicants request a complete and prompt examination of each and every element recited in claims 1, 14 and 63.

Additionally, applicants submit that the cited references fail to teach or suggest at least the above-referenced features. As a result, claims 1, 14 and 63, as well as the claims dependent thereon, are allowable.

Furthermore, since the Office Action fails to establish a prima facie case for rejecting the above-referenced features of the independent claims as previously presented, which features are retained by the present Amendment, applicants request that any next Office Action rejecting the above-referenced claim features be **NON-FINAL**.

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2) Cited References Do Not Disclose Discovering/Deploying a Solution Without Further User Interaction in Response to Receiving Input to Open a Data File

The Office Action on page 2 asserts that Kaker et al. discloses discovering/deploying, without user interaction, a solution (citing paragraph 125). Applicants disagree.

Kaker et al. discloses an online system for providing prescription assistance for indigent patients using programs provided by pharmaceutical manufacturers (see abstract). Kaker et al. states in paragraph 125 (emphasis added):

The Prescription Form Page 56 may be accessed by clicking the appropriate hyperlinked text statement on the Auto Fill Page 38. The request forwarded to the web server includes parameters specifying all of the information recorded in the Prescription Form on the Auto Fill Page 38. The server redirects the user to a PDF file that stores a copy of the manufacturer's Fill-In Form which is automatically filled with the appropriate data from the Prescription Form. A suitable software, such as the Adobe Acrobat, Adobe Systems, Inc., must be used by the user in order to view the form 58, edit the content that was autofilled and print it. The user can then complete the form (with signature, if required) and send it to the appropriate location.

Therefore, Kaker et al. explicitly requires that in order to view, edit and print the manufacturer's Fill-In Form, a user must first obtain and use suitable software (e.g., Adobe Acrobat). As discussed during the interview, this is in stark contrast to receiving input from a user to merely open a data file, and then in response to receiving the input to open the data file, discovering a solution or deploying the solution without further user interaction. As discussed in the present specification in paragraph 28 (emphasis added)

... If a user has opened the data file first online, or if the system has otherwise received the data file's solution, an electronic forms application can silently discover and deploy the data file's solution. The data file's solution declaratively defines aspects of the data file such as its elements, attributes, and values, as will be discussed below. The electronic forms application allows a user to simply select a data file to open and the electronic forms application will

open the data file with a discovered and deployed solution. The user need not discover, select, or even be aware that the data file requires a solution for the data file to be edited. After selecting the data file to open, the user can then edit and access the data file in a way very similar to how it would act and appear had the user opened the data file while online.

The Office Action on pages 3-4 also asserts that Green et al. cures the defects in Kaker et al. Applicants disagree.

Green et al. at most discloses that clicking a “Print” button displays a PDF version of a document suitable for printing (see col. 12, lines 61-67). Therefore, Green et al. explicitly teaches that a PDF version of a document is displayed specifically in response to clicking a “Print” button. However, as discussed during the interview, Green et al. is completely silent as to the features of in response to receiving input to open a data file, discovering a solution without further user interaction.

As a result, Kaker et al. and Green et al. fail to teach or suggest at least the following elements of independent claims 1 and 14, respectively (emphasis added):

1. A computer-implemented method, comprising:
a computer receiving input from a user to open a data file;
in response to receiving the input to open the data file,
discovering, without further user interaction, a solution, the
solution defining an availability of one or more actions for
formatting data in one or more operable fields of an electronic
form associated with the data file, wherein the availability of one
or more actions is defined for each one of the one or more operable
fields;
deploying, without user interaction, the solution;
...
 14. One or more computer-readable storage media having
stored thereon a plurality of computer-executable instructions
performing steps comprising:
receiving input from a user to open a data file;
in response to receiving the input to open the data file,
discovering, without further user interaction, a solution, the
solution defining an availability of one or more actions for

formatting data in one or more operable fields of an electronic form associated with the data file, wherein the availability of one or more actions is defined for each one of the one or more operable fields;

deploying, without user interaction, the solution;

...

For similar reasons, Kaker et al. and Green et al. fail to teach or suggest at least the following elements of independent claim 63 (emphasis added):

63. An apparatus comprising:

...

means for selecting the data file by a user using the user interface;

means for discovering and deploying, in response to the selecting by the user and without further user interaction, a solution governing the data file, wherein the solution defines an availability of one or more actions for formatting data into one or more operable fields of an electronic form associated with the data file, wherein the availability of one or more actions is defined for each one of the one or more operable fields;

...

Capps and Venkatesh et al. also fail to teach or suggest, and are not cited by the Office Action as teaching or suggesting, the features discussed above that are missing from Kaker et al. and Green et al.

3) Kaker et al., Capps, Venkatesh et al. and Green et al. Fail to Teach or Suggest All of the Elements of the Independent Claims

Therefore, since Kaker et al., Capps, Venkatesh et al. and Green et al., alone or in combination, fail to disclose or suggest all of the elements of independent claims 1, 14 and 63, these claims are allowable.

Claims 2-6 and 8-13 depend from claim 1. Claim 64 depends from claim 63. As discussed above, claims 1 and 63 are allowable. For at least this reason, and the additional features recited therein, claims 2-6, 8-13 and 64 are also allowable.

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For at least the reasons above, reconsideration and withdrawal of the rejection of claims 1-6, 8-14 and 63-64 under 35 U.S.C. §103(a) are respectfully requested.

B. Rejections Based on Kaker et al., Capps, Venkatesh et al., Green et al. and Turpin

The Office Action rejects claim 65 under 35 U.S.C. §103(a) as being unpatentable over Kaker et al. in view of Capps, Venkatesh et al. and Green et al., and further in view of Turpin (5,640,501). Applicants respectfully traverse this rejection for at least the following reasons.

As discussed above, Kaker et al., Capps, Venkatesh et al. and Green et al., alone or in combination, fail to disclose or suggest all of the elements of independent claim 63. Turpin fails to cure this defect.

Turpin is cited by the Office Action primarily for its teaching of various editing and formatting operations (citing Fig. 6; col. 16, line 46 – col. 17, line 46). However, Turpin fails to teach or suggest at least the elements discussed above with respect to claim 63.

Therefore, since Kaker et al., Capps, Venkatesh et al., Green et al. and Turpin, alone or in combination, fail to disclose or suggest all of the elements of independent claim 63, this claim is allowable.

Claim 65 depends from claim 63. As discussed above, claim 63 is allowable. For at least this reason, and the additional features recited therein, claim 65 is also allowable.

For at least the reasons above, reconsideration and withdrawal of the rejection of claim 65 under 35 U.S.C. §103(a) are respectfully requested.

2. Conclusion

Accordingly, in view of the above amendment and remarks it is submitted that the claims are patentably distinct over the cited art and that all the rejections to the claims have been overcome. Reconsideration and reexamination of the present application is requested. Based on the foregoing, applicants respectfully request that the pending claims be allowed, and that a timely Notice of Allowance be issued in this case. If the Examiner believes, after this

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amendment, that the application is not in condition for allowance, the Examiner is requested to call the applicants' attorney at the telephone number listed below.

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If this response is not considered timely filed and if a request for an extension of time is otherwise absent, applicants hereby request any necessary extension of time. If there is a fee occasioned by this response, including an extension fee that is not covered by an enclosed check please charge any deficiency to Deposit Account No. 50-0463.

Respectfully submitted,
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Date: April 2, 2010

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April 7, 2010
Date

/Noemi Tovar/
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